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Paul A. Leipold Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201				FAISON GEE, VERONICA FAYE
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DELAINA A. ALLEN
and L. RONALD WHITLOCK

Appeal 2008-2789
Application 10/748,888
Technology Center 1793

Decided: June 26, 2008

Before BRADLEY R. GARRIS, CHUNG K. PAK, and PETER F. KRATZ,
Administrative Patent Judges.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's
decision rejecting claims 1-20. We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM.

Appellants claim a pigment-based ink composition for inkjet printing wherein the composition has certain filterability as determined by a particular test (claim 1).

Representative independent 1 claim reads as follows:

1. A pigment-based ink composition for inkjet printing the ink composition comprising pigment particles, wherein said ink composition has a filterability of at least 80% wherein filterability is determined by the following test; a sample of said pigment-based ink is divided into four 100 ml aliquots and a first aliquot is filtered through a chemically inert membrane having a porosity of 1.0 μ m and a diameter of 47 mm and using a vacuum of 20 inches of Hg and measuring the time it takes to complete the filtration, T1, a second and third aliquot are sequentially passed through the same filter under the same filtering conditions, the fourth aliquot is then passed through the same filter under the same conditions while measuring the time it takes to complete the filtration of the fourth aliquot, T4, the time of T1 is divided by T4 and multiplied by 100 to obtain the filterability.

The reference set forth below is relied upon by the Examiner as evidence of unpatentability:

Yu 6,494,943 B1 Dec. 17, 2002

All appealed claims are rejected under 35 U.S.C. § 102(b) as being anticipated by or alternatively under 35 U.S.C. § 103(a) as being obvious over Yu.

Appellants separately argue claims 1, 9, 10, and 16. These claims will be separately considered below. The remaining claims on appeal will stand or fall with claim 1 from which they all ultimately depend.

For the reasons expressed in the Answer and below, the above-noted rejection will be sustained.

The Examiner finds that the pigment-based ink composition of Yu appears to be compositionally identical to the claimed composition. (Yu: col. 3, ll. 7-29, col. 4, ll. 16-39, col. 16, l. 55 to col. 17, l. 14; Ans. 3-4). Therefore, even though patentee's ink composition is not disclosed as having the filterability defined by the particular test recited in claim 1, the Examiner determines that the ink composition of Yu would inherently possess this filterability characteristic. (Ans. 4).

Appellants argue that the comparative ink data in their Specification provides clear evidence that the inks disclosed by Yu are not inherently the same as "the instant invention." (Br. 5). This argument is unpersuasive.

On this record, no basis exists for considering the comparative ink data of Appellants' Specification to be representative of Yu's ink composition including the most preferred composition which includes pigments having a particle size distribution range of from about 50 nm to about 100 nm (col. 4, ll. 16-24) and which completely filters through a one to two micron nylon absolute filter (col. 4, ll. 34-39). Significantly, Appellants' argument does not specifically address Yu's most preferred composition.

Under these circumstances, the Examiner's rejection based on inherency is justified. Where, as here, the claimed and prior art compositions appear to be identical, it is reasonable for the Patent and Trademark Office (PTO) to believe that the respective compositions must have the same properties. *See In re Spada*, 911 F.2d 705, 708-09 (Fed. Cir. 1990). In such an event, the PTO can require an applicant to prove that the prior art product or composition does not necessarily or inherently possess the characteristics of the claimed product or composition. *In re Best*, 562

F.2d 1252, 1255 (CCPA 1977). Whether the rejection is based on § 102 or § 103, the burden of proof is the same, and its fairness is evinced by the inability of the PTO to obtain and compare prior art products or compositions. *Id.*

For these reasons, the Examiner’s rejection of claim 1 is proper on the record before us.

For analogous reasons, the corresponding rejection of separately argued claim 16 also is proper. That is, while Yu is silent as to whether patentee’s ink composition possesses the claim 16 capability of jetting “through a print head having an orifice size of 25 micrometers for greater than 10 hours,” it is reasonable to consider patentee’s composition as having this capability in light of its apparent identity to Appellants’ claimed ink composition. Moreover, the reasonableness of this determination is reinforced by the fact that patentee’s ink composition is specifically intended and designed to prevent clogging of ink channels and nozzles (col. 16, ll. 59-66).

Finally, Appellants argue that the mean particle size of the pigment particles as defined by dependent claims 9 and 10 “is not disclosed or suggested by Yu” (Br. 6). This argument is based on a factually erroneous premise. Yu expressly teaches that a preferred average particle size for pigments of an ink composition is in a range from about 0.005 micron to about 0.3 micron (col. 16, ll. 66 to col. 17, l. 3). This size range substantially encompasses the ranges defined by claims 9 and 10.

In light of the foregoing and for the reasons set forth in the Answer, we sustain the Examiner’s § 102 and § 103 rejection of all appealed claims as being unpatentable over Yu.

Appeal 2008-2789
Application 10/748,888

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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